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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,936	03/28/2001	Walter Eevers	Q63636	9629

7590 06/24/2005

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EXAMINER	
COLE, ELIZABETH M	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/818,936	EEVERS ET AL.	
	Examiner	Art Unit	
	Elizabeth M. Cole	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3, 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al, U.S. Patent No. 5,229,185. Shiota et al discloses a tape comprising a perforated resin film (2) which has a non-perforated adhesive layer (3) coated on one side. See fig. 1, as well as col. 2, lines 29-53. The backing layer of the tape may further comprise a nonwoven fabric. See col., 2, line 57. The adhesive layer may be a hot melt or pressure sensitive adhesive. See col. 2, lines 66-68. Shiota differs from the claimed invention because it does not disclose the cavity ratio or tensile strength or elongation. With regard to the cavity ratio, since Shiota teaches a porosity of greater than 30%, where porosity is defined as the ratio of the total area of the perforation to the total area of the sheet, it seems that a porosity of at least 30% would encompass the claimed cavity ratio. With regard to the claimed elongation and tensile strength, it would have been obvious to have selected the resin film so that it had desirable, strength, elongation, elasticity, etc. With regard to the limitation that the tape is for use in processing semiconductors, although the tape of Shiota et al is used for different purposes, since the tape of Shiota is capable of performing the intended use and has the claimed structure, Shiota meets that limitation.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al as applied to claims above, and further in view of JP 09-272,850. Shiota discloses a

tape as set forth above. Shiota does not teach the particularly claimed type of adhesive. JP '850 teaches employing acrylic adhesives as pressure sensitive adhesives. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed an acrylic pressure sensitive adhesive as the pressure sensitive adhesive in Shiota, because of their art recognized suitability for the intended purpose.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites a method of processing semiconductors comprising a step of "fixing a semiconductor wafer or semiconductor material with the water-permeable adhesive tape according to claim 1" but it is not clear what is mean by "fixing". Does this mean applying the tape of claim 1 to a semiconductor material? In what way does this constitute "processing"?

5. Applicant's arguments filed 4/18/05 have been fully considered but they are not persuasive. In response to applicant's argument that the tape of Shiota, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the claimed structures are

the same. Applicant argues that the adhesive extends only over the perforations at the periphery of the structure in Shiota. However, the instant claims require only that there be a base film having perforations and an adhesive layer not having perforations applied on the perforated base layer. The structure of Shiota meets these limitations. The claims do not require that the adhesive and perforated layers be co-extensive. Applicant argues that modifying the Shiota reference would destroy the Shiota tape. However, the instant rejection does not require that the Shiota reference be modified by extending the adhesive over the surface of the perforations.

6. Applicant argues that the tape of Shiota is not water permeable. However, since the Shiota tape has the same structure it has to have the same properties.

7. With regard to the 112 2nd paragraph rejection, Applicant argues that the term "fixing' is definite when considered in light of the disclosure. However, claim 9 recites a method of processing comprising a step of fixing a semiconductor wafer with the water-permeable tape. However, the claim does not disclose any method steps in the processing process other than "fixing". The claim is therefore indefinite because it is not clear how applying a tape to a semiconductor can be construed as processing the tape. Further, the term "fixing" can be construed to mean repairing. While claims are read in light of the specification, limitations from the specification are not read into the claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.

Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c